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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/655,273	09/05/2000	C. Douglass Thomas	CDTP006	8031

7590
C Douglass Thomas
1193 Capri Drive
Campbell, CA 95008

07/13/2005

EXAMINER

RIMELL, SAMUEL G

ART UNIT	PAPER NUMBER
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2165

DATE MAILED: 07/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/655,273

Applicant(s)

THOMAS, C. DOUGLASS

Examiner

Samuel G. Rimell

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 April 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 6-12,16,17,19,20 and 22-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 6-12,16,17,19,20 and 22-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119


- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.


SHAHID ALAM
PRIMARY EXAMINER

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed on 14 April 2005 have been fully considered but they are not persuasive for the following reasons:

Applicant argues Freivald contains no teaching or suggestion for copyright registrations or for the need to update copyright registrations; Glogau completely fails to provide any teaching or suggestion regarding updating copyright registrations; there is no teaching, suggestion, hint or motivation to combine these references as the Examiner proposes; the combination of these references must then be the result of improper hindsight because the only suggestion or motivation to make this combination is from Applicant's own application; and the Examiner has failed to make out a prima facie rejection.

Examiner respectfully disagrees all of the allegations as argued. Examiner, in his previous office action, gave detail explanation of claimed limitation and pointed out exact locations in the cited prior art.

Examiner is entitled to give claim limitations their broadest reasonable interpretation in light of the specification.

Interpretation of Claims-Broadest Reasonable Interpretation

During patent examination, the pending claims must be 'given the broadest reasonable interpretation consistent with the specification.' Applicant always has the opportunity to amend the claims during prosecution and broad interpretation by the examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than is justified. In re Prater, 162 USPQ 541,550-51 (CCPA 1969).

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In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

In response to applicant's argument on page 11, a prima facie case of obviousness is established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art. Once such a case is established, it is incumbent upon appellant to go forward with objective evidence of unobviousness. *In re Fielder*, 471 F.2d 640, 176 USPQ 300 (CCPA 1973).

In response to applicant's arguments against the references individually,

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one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Freivald's teaches change-detection server to **register** a web page document for **change** detection, periodically re-fetch the document and **compare for changes** and **e-mail a change notice** to the registered user if a change is detected and Glogau teaches **a web site copyright registration system**. Freivald and Glogau are combinable because both of them teach registration system as claimed in the instant application.

For the above reasons, Examiner believed that rejection of the last Office action was proper.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 6 – 11, 16 – 17, 19 – 20, 22 – 24 and 27 – 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Number 5,898,836 issued to Matthew P. Freivald et al. ("Freivald") and in view of U.S. Patent Number 5,983,351 issued to Jordan J. Glogau ("Glogau").

With respect to claim 19, Freivald outlines the steps of registering a web page document and periodically re-fetching the document (see column 6, lines 49 – 50). The re-fetched document is compared to the originally registered document. The result of the comparison is a change indication (a change in a calculated CRC value, column 6, lines 60 – 67). In response to a sufficient degree of change in the CRC value, a determination is made for the need of an update action. The update action may a correction links on the stored page (column 13, line 65 – column 14, line 10).

Freivald does not explicitly teach the websites as having any copyright registration or the steps of updating a United States copyright registration as claimed.

Glogau teaches the general principle that a website may be copyrighted. Glogau further teaches the concept of reviewing website content and then subsequently generating the form to initiate a United States copyright registration (see abstract and column 2, lines 15 – 55).

It would have been obvious to a person of ordinary skill in the art at the time of the invention was made to modify Freivald to incorporate copyrights registered documents in order to facilitate the protection of the intellectual property in those documents. In would further have been obvious to modify Freivald to add a copyright registration functionality to the web management system of Freivald in order to provide intellectual property protection to the reviewed web documents as taught by Glogau.

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As to claim 6, Freivald discloses the steps of identifying an address location (column 6, lines 49 – 50);

periodically crawling the address to determine content change (column 6, lines 51 – 52); and

determining a degree of change (column 6, lines 38 – 40) as compared to a prior website. When a degree of change exceeds a certain threshold, a determination is made that a certain action must be taken. Glogau teaches that such an action may be a copyright registration.

As to claims 7, 20 and 27, when the action is taken, a notification to a contact is made (column 6, lines 65 – 67; Freivald).

As to claims 8, 22, 28 and 29, the notification may be an e-mail notification (column 6, lines 53 – 54 and 65 – 67; Freivald).

As to claims 9 and 30, the e-mail notification can include information on the amount of content change that has occurred (column 12, lines 21 – 27; Freivald).

As to claims 10 and 31, the system of Freivald can indicate where the changes to the document have occurred. For example, changes to specific hyperlinks (column 13, line 65 – column 14, line 9) on a page can be indicated to the user.

As to claim 11, Freivald teaches that when a certain degree of change is detected, a certain action must be taken. Glogau teaches the action to be one of performing a United States copyright registration.

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As to claim 16, Glogau teaches that a copyright registration is performed, and that the registration may be on-line and interactive (column 7, lines 9 – 14).

As to claim 17, Glogau refers to the registration of an entire website and its individual components (column 2, lines 46 – 49). Thus, registering one of these types of works can be designated as a "previous registration" and the other, a subsequent registration. A registration of a website will inherently reference at least some of the website components.

As to claim 23, the copyright registration is authorized to be performed when it is initiated.

The steps that initiate the copyright registration are the authorization steps.

The subject matter of claim 24 is rejected in the analysis above in claim 19 and this claim is rejected on that basis. The subject matter of Freivald can initiate more than just one single copyright registration and any copyright registration initiated which is subsequent to some previously initiated registration is a subsequent registration.

3. Claims 12, 25, 26, 32 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Freivald in view of Glogau and further in view of "Information Today" (Article from Information Today entitled "Library of Congress and Copyright Office Sign Agreement with UMI", published March 1999).

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With respect to claims 12 and 25, Freivald and Glogau do not explicitly teach on-line filing of a copyright registration with the U.S. Copyright Office as claimed.

Glogau teaches that a copyright registration is performed, and that the registration may be on-line and interactive (column 7, lines 9 – 14). "Information Today" teaches the development of system referred to as "CORDS" which permits registration and payment for copyright registrations on-line for U.S. Copyright registrations.

It would have been obvious to one of ordinary skill in the art to modify Glogau, which teaches the generation of electronic copyright forms, to further permit on-line filing of the electronic form. Such combination would permit more efficient copyright registration, as specifically taught by "Information Today".

As to claims 26, 32 and 33, it would have been obvious to one of ordinary skill in the art to modify Glogau, which teaches the generation of electronic forms, to further permit on-line filing of the electronic forms. Such a combination would permit efficient copyright registration, as specifically taught by "Information Today". "Information Today" further teaches the feature of providing on-line deposits of fees. Since a deposit of a fee is considered an act of pre-authorization, it would also have been obvious to modify the system of Glogau to include a functionality, which permits deposits to be made for copyright fees to the U.S. Copyright Office. This would also serve to permit efficient copyright registration, as taught by "Information Today".

Conclusion

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


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Contact Information

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Samuel G. Rimell whose telephone number is (571) 272- 4084. The examiner can normally be reached on Monday-Thursday 8:00 A.M.- 4:00 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Gaffin can be reached on **571-272-4146**. The fax phone number for the organization where this application or proceeding is assigned is **571-273-8300**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Shahid Al Alam
Primary Examiner
Art Unit 2162

for SAM RIMELL

7 July 2005